

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT R. DOWNS and OLENA E. DOWNS

Appeal No. 1997-2683
Application No. 08/590,016

ON BRIEF

Before URYNOWICZ, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 2. Claims 3-7 have been indicated by the Examiner as containing allowable subject matter.

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The claimed invention relates to a self-inspection apparatus which includes a mirror supported by a frame having first and second side members connected to first and second cross-members. More particularly, Appellants indicate at pages 3 and 4 of the specification that the frame is placed and held along the front edge of a toilet bowl in a position facing the toilet bowl. Appellants assert that this arrangement permits easy inspection combined with easy access to the genital region.

Claim 1 is illustrative of the invention and reads as follows:

1. A self-inspection apparatus, comprising:

a mirror; and

a frame placeable along the front edge of a toilet bowl and secured thereto by a toilet seat for holding said mirror in front of the exterior surface of the toilet bowl in a position facing the toilet bowl.

The Examiner relies on the following prior art:

Shutt	3,989,359	Nov. 02, 1976
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Claims 1 and 2 stand finally rejected under 35 U.S.C.

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§ 102(b) as being anticipated by Shutt. In a separate rejection, claims 1 and 2 stand finally rejected under 35 U.S.C. § 103 as being obvious over Shutt.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that Shutt does not fully meet the invention as set forth in claims 1 and 2. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the

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obviousness of the invention as recited in claims 1 and 2.
Accordingly, we reverse.

We consider first the rejection of claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by Shutt. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 1, the Examiner attempts to read the various claim limitations on the illustrations in Figures 1 through 6 of Shutt. In particular, the Examiner (Answer, page 4) points to the Figure 1 illustration in Shutt as showing at least a portion of mirror 11 and frame 15 in front of the exterior surface of a toilet bowl.

In response, Appellants assert (Brief, page 3) that Shutt's mirror is held within the toilet bowl and does not face the toilet bowl as claimed. We agree. Although an Examiner is permitted some latitude in interpreting a prior art reference for application against claim language, we can conceive of no reasonable interpretation of Shutt which would lead to the conclusion that Shutt's mirror is held "in front of the exterior surface of the toilet bowl in a position facing the toilet bowl" as required by Appellants' claim 1.

We further consider to be unfounded the Examiner's assertion that the language "placeable along the front edge...toilet bowl" and "for holding...toilet bowl" which appears in the body of Appellants' claim 1 can be characterized as statements of intended use and thereby disregarded when determining patentability. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 983, 180 USPQ 580, 582 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1282, 1385, 165 USPQ

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494, 496 (CCPA 1970). Here, the language "placeable" and "for holding" limits the structure. The structure of Shutt is incapable of being placed along the front edge of the toilet bowl while functioning to hold the mirror facing the toilet bowl.

In view of the above discussion, it is our opinion that, since all of the claim limitations are not present in the disclosure of Shutt, the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 1, as well as claim 2 dependent thereon, can not be sustained.

Turning to a consideration of the Examiner's separate rejection of claims 1 and 2 as being obvious under 35 U.S.C. § 103, we do not sustain this rejection as well. The Examiner's line of reasoning in support of the obvious rejection is set forth at page 4 of the Answer as follows:

[I]t certainly would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the frame (12-18, 20, 26-28 and 30) of Shutt to be bent in such a manner in order that said mirror extends in front of the exterior surface of the toilet bowl in a position facing the toilet bowl to accommodate for obese people.

Our review of the record in this case, however, reveals a total lack of evidence to support the Examiner's position.

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While we do not totally disagree with the Examiner's apparent observation that Appellants' device would be difficult to utilize for anyone not of a standard size and body shape, this fact alone does not, in our view, support the Examiner's conclusion of obviousness. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our opinion, although Shutt does suggest minor adjustment of his device to accommodate the particular contour of different toilet seats (Shutt, column 2, lines 55-57), the complete redesign of Shutt that would be required to arrive at the claimed invention would be possible only with improper hindsight reconstruction of Appellants' device. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of appealed claims 1 and 2.

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In conclusion, we have not sustained either of the
Examiner's rejections of the claims on appeal. Accordingly,
the Examiner's decision to reject claims 1 and 2 is reversed.

REVERSED

STANLEY M. URYNOWICZ JR.,)	
Administrative Patent Judge)	
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LEE E. BARRETT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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smu/rwk

DONALD R COMUZZI
1631 MILAM BUILDING
115 EAST TRAVIS STREET
SAN ANTONIO TX 78205